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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,098	10/14/2004	Akira Ideno	Q83564	9139
23373 7590 03/23/2007 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EXAMINER PROUTY, REBECCA E	
			ART UNIT	PAPER NUMBER
			1652	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
31 DAYS		03/23/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/511,098	Applicant(s) IDENO ET AL.	
	Examiner Rebecca E. Prouty	Art Unit 1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-64 is/are pending in the application.
- 4a) Of the above claim(s) 57 and 58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 33-56 and 59-64 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Claims 1-32 have been canceled. Claims 33-64 are at issue and are present for examination.

Applicant's election with traverse of Group I, claims 33-56 and 59-64 in the reply filed on 10/26/06 is acknowledged. The traversal is on the ground(s) that there would be no burden of search for the coexamination of claims 57-58 with the elected claims. This is not found persuasive because while the search for the elected group would be overlapping it would not be coextensive with that of the non-elected claims as search of the products of the non-elected claims would require search of material which would disclose the same product made by different methods (as patentability of product-by-process claims is determined by the limitations of the product itself and not by the method by which it is made) while such art would not be applicable to the elected claims. Applicants also request rejoinder of the non-elected claims upon allowance of the elected claims. However, it is noted that even upon allowance of the elected claims, rejoinder of claims 57 and 58 would not be appropriate. The elected claims recite process claims. The rejoinder rules require the rejoinder of methods of making or using an allowable product with the allowable product. There is no provision in the rejoinder rules for rejoinder of a product made an allowable method.

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Claims 57 and 58 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 10/26/06. Furthermore, upon review of the claims of the elected group an additional restriction is deemed to be necessary. Therefore restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group A, claim(s) 33-37, 40-42, 53-56, and 59-64, drawn to a vector for producing a fusion protein comprising an archaebacterial short-type FKBP-type peptidyl-prolyl isomerase (PPIase) and methods of producing a fusion protein therefrom.

Group B, claim(s) 33-37, 40, 42, 53-56, and 59-64, drawn to a vector for producing a fusion protein comprising an archaebacterial long-type FKBP-type PPIase and methods of producing a fusion protein therefrom.

Group C, claim(s) 33-37, 43, 44, 53-56, and 59-64, drawn to a vector for producing a fusion protein comprising an trigger factor-type PPIase and methods of producing a fusion protein therefrom.

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Group D, claim(s) 33-37, 45, 46, 53-56, and 59-64, drawn to a vector for producing a fusion protein comprising an FKpA-type PPIase and methods of producing a fusion protein therefrom.

Group E, claim(s) 33-37, 47, 48, 53-56, and 59-64, drawn to a vector for producing a fusion protein comprising an FKBP52-type PPIase and methods of producing a fusion protein therefrom.

Group F, claim(s) 33-36, 38, 49, 50, 53-56, and 59-64, drawn to a vector for producing a fusion protein comprising an CyP40-type PPIase and methods of producing a fusion protein therefrom.

Group G, claim(s) 33-36, 39, 51-56, and 59-64, drawn to a vector for producing a fusion protein comprising an SurA-type PPIase and methods of producing a fusion protein therefrom.

The inventions listed as Groups A-G do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the only shared technical feature among groups A-G is that they all relate to a vector for producing a fusion protein comprising a chaperone protein and methods of producing a fusion protein therefrom. However this shared technical feature is not a special technical feature as defined by PCT Rule 13.2 as it does not define a contribution over the art. Fersht et al. (WO 00/75346, see applicants IDS of 10/14/04) teach a vector for producing a fusion protein comprising a chaperone protein and methods of producing a fusion protein therefrom.

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Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

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remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rebecca E. Prouty whose telephone number is 571-272-0937. The examiner can normally be reached on Tuesday-Friday from 8 AM to 5 PM. The examiner can also be reached on alternate Mondays

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (571) 272-0928. The fax phone number for this Group is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Rebecca Prouty
Primary Examiner
Art Unit 1652